REMARKS:

In the outstanding Office Action, the Examiner rejected claims 1-13. Claims 1, 4, 5 and 9-13 are amended herein, and new claim 14 is added. No new matter is presented. Thus, claims 1-14 are pending and under consideration. The rejections are traversed below.

REJECTION UNDER 35 U.S.C. § 101:

Claims 1, 4 and 13 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (Claims 2, 3 and 8 depend from claim 1 and claims 5, 6 and 7 depend from claim 4).

On page 6 of the outstanding Office Action, the Examiner indicated that the claims raise a question as to whether the claims is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, tangible result to form the basis of statutory subject matter under 35 U.S.C. § 101. The Examiner further indicated that the claims do not expressly or implicitly require performance of any of the steps by a machine such as a general-purpose digital computer (see, page 6 of the Office Action).

In light of a recently decided case of Ex parte Lundgren, Applicants respectfully request that the rejection of claims 1, 4 and 13 including claims depending from the same be removed.

In Ex parte Lundgren, the Board of Patent Appeals and Interferences (BPAI) considered: (1) whether the invention as a whole is in the technological arts; and (2) assuming that the invention is in the technological arts, whether the claim transferring compensation to a manager is a practical application (see, Ex parte Lundgren, Appeal No. 2003-2088 at page 3). The BPAI held that "there is currently no judicially recognized separate technological arts test to determine patent eligible subject matter under § 101" (Ex parte Lundgren, Appeal No. 2003-2088 at page 6). On pages 4 and 5 of Ex parte Lundgren, the BPAI specifically overruled the Examiner's requirement that the claim recite use of a computer. The Examiner's requirement that the claims recite operations by a computer are respectfully traversed.

Therefore, it is respectfully submitted that claims 1, 4 and 13 including claims depending there from are directed to non-statutory subject matter, and therefore, removal of the rejection is respectfully requested.

PRIORITY OBJECTION:

Applicants respectfully submit that in accordance with 37 C.F.R. § 1.55, a certified copy identifying Japanese Patent Application No. 2000-115239 (Filed: April 17, 2000) was submitted on January 19, 2001, the filing date of the present application.

In light of the above, Applicants respectfully request withdrawal of the objection.

REJECTION UNDER 35 U.S.C. § 112¶1 AND § 112¶2:

At pages 7 and 8 of the outstanding Office Action, claims 1-3, 5 and 8 were rejected under 35 U.S.C. § 112. Claims 1 and 5 are amended (claims 2 and 3 depend from claim 1). Claim 8 is supported by the Specification at least at paragraphs 54 and 55.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-3, 8 and 11-13 are being rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,199,204 (Donohue).

Donohue distributes updates of computer programs by selecting from product updates listed at a web site based on an update list to determine whether an update is necessary (see, col. 11, lines 26-67). That is, Donohue uses a list indicating release numbers to identify and locate a product update (see, column 8, lines 26-36).

In contrast, the present invention analyzes feature points, such as those of a macro or a format used by a document file including not only the text document prepared by, for example, Microsoft™ Word etc., but also a worksheet of Microsoft™ Excel or materials for presentation prepared by Microsoft™ Powerpoint. As such, the present invention determines the application program including different versions required for utilizing a document file, and installs the application program if the required application program is not installed in the system. Accordingly, it possible to properly process a document file, for example, attached to an electronic mail received.

Independent claims 1 and 11-13 recite, "extracting at least one of a plurality of feature points in a data file after having analyzed the data file", where the feature point is "a content within the data file and indicative of a format used to create the data file."

Donohue does not teach or suggest that the feature point indicates "a format used to create the data file" and is "a content within the data file", as recited in claims 1 and 11-13.

It is submitted that the independent claims are patentable over Donohue.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over Donohue. The dependent claims are also independently patentable. For example, as recited in claim 3, "the feature point is a syntax pattern of a macro instruction included in the data file" and "the version of the application program is decided by extracting the syntax pattern and determining the version of the application program enabled to read the syntax pattern." Donohue does not teach or suggest these features of claim 3.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 4, 5-7, 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Donohue and U.S. Patent No. 6,282,712 (Davis).

Independent claims 4, 9 and 10 recite that the feature points are "indicative of corresponding formats used to create the data files" and are "contents within the data files" for "selecting a version of the application program in which a data file is readable based on at least one of the feature points" ("which can read the readable data file" in claims 9 and 10).

On the other hand, Davis is directed to software installation in accordance with a listing of inventory information of computers in a distributed network (see, column 8, lines 12-17). That is, the inventory information list in Davis merely lists the software installed on the computers.

The combination of Davis and Donohue does not teach or suggest that the feature points are "indicative of corresponding formats **used** to create the data files" (emphasis added), and are "contents within the data files", as recited in independent claims 4, 9 and 10.

It is submitted that the independent claims 4, 9 and 10 are patentable over the combination of Davis and Donohue.

For at least the above-mentioned reasons, dependent claims 5-7 are also patentably distinguishable over the combination of Davis and Donohue.

Therefore, withdrawal of the rejection is respectfully requested.

NEW CLAIM:

New claim 14 has been added to recite, "determining a version of a first application program used to create a document file a user is requesting to access from a content within the document file" and "installing the version of the first application program or a second application program", where the second application program is "similar to the first application program and [is] able to read the document file in accordance with said determining of the version of the first application program from the content within the document file."

The cited references, alone or in combination, do not teach or suggest the above-discussed features of claim 14.

It is submitted that new claim 14 is patentably distinguishable over the cited references.

CONCLUSION: ⁄

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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